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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,495	10/23/2001	Jennifer L Hillman	PF-0698 USN	4335
22428	7590	06/30/2004	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			BASI, NIRMAL SINGH	
			ART UNIT	PAPER NUMBER
			1646	

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/019,495	Applicant(s) HILLMAN ET AL.	
	Examiner Nirmal Basi, Ph.D.	Art Unit 1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15,17,18,20,21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-15,17,18,20,21 and 23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

PART A: TYPES OF INVENTIONS

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group A-I, claim(s) 1-6, 8, 10-11, 15, drawn to polypeptides, pharmaceutical compositions comprising the polypeptide, polynucleotides encoding the same, cells transformed with the polynucleotides, and methods of producing the encoded polypeptides.

Group A-II, claim(s) 7, drawn to a transgenic organism.

Group A-III, claim(s) 9, drawn to an antibody.

Group A-IV, claim(s) 12-14, drawn to methods for detecting a target polynucleotide.

Group A-V, claim(s) 17 and 20, drawn to methods for identifying agonists and antagonists.

Group A-VI, claim(s) 18 and 21, drawn to pharmaceutical compositions comprising agonists or antagonists.

Group A-VII, claim(s) 23, drawn to a method for screening a compound for effectiveness in altering expression of a target polynucleotide.

The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the special technical feature of Group I is the recited polypeptide and polynucleotide. The related first claimed method of making and using the first claimed products, i.e., the method of using the polynucleotides to make the encoded protein, is included in Group I because the PCT rules provide for the examination of the first claimed product, first claimed method of making the product, and first claimed method of using the product in one application.

However, Groups II, III and VI are directed to additional products wherein the products have additional features (e.g., the animal) or different structures (e.g., the antibody or agonist/antagonist) such that separate searches would have to be conducted for these products. The PCT rules do not provide for the examination of multiple [products in one application. Similarly, the methods of Groups IV and V involve method steps that are distinct from the method of Group I, requiring significant additional searching. The PCT rules do not provide for the examination of multiple methods in a single application.

PART B: TYPES OF SEQUENCES

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group B-I, claim(s) 1-15, 17, 18, 20, 21 and 23 as they relate to SEQ ID NO: 1.

Group B-II, claim(s) 1-15, 17, 18, 20, 21 and 23 as they relate to SEQ ID NO: 2.

Group B-III, claim(s) 1-15, 17, 18, 20, 21 and 23 as they relate to SEQ ID NO: 3.

Group B-IV, claim(s) 1-15, 17, 18, 20, 21 and 23 as they relate to SEQ ID NO: 4.

Group B-V, claim(s) 1-15, 17, 18, 20, 21 and 23 as they relate to SEQ ID NO: 5.

Group B-VI, claim(s) 1-15, 17, 18, 20, 21 and 23 as they relate to SEQ ID NO: 6.

Group B-VII, claim(s) 1-15, 17, 18, 20, 21 and 23 as they relate to SEQ ID NO: 7.

Group B-VIII, claim(s) 1-15, 17, 18, 20, 21 and 23 as they relate to SEQ ID NO: 8.

Group B-IX, claim(s) 1-15, 17, 18, 20, 21 and 23 as they relate to SEQ ID NO: 9.

Group B-X, claim(s) 1-15, 17, 18, 20, 21 and 23 as they relate to SEQ ID NO: 10.

Group B-XI, claim(s) 1-15, 17, 18, 20, 21 and 23 as they relate to SEQ ID NO: 11.

Group B-XII, claim(s) 1-15, 17, 18, 20, 21 and 23 as they relate to SEQ ID NO: 12.

Group B-XIII, claim(s) 1-15, 17, 18, 20, 21 and 23 as they relate to SEQ ID NO: 13.

Group B-XIV, claim(s) 1-15, 17, 18, 20, 21 and 23 as they relate to SEQ ID NO: 14.

Group B-XV, claim(s) 1-15, 17, 18, 20, 21 and 23 as they relate to SEQ ID NO: 15.

Group B-XVI, claim(s) 1-15, 17, 18, 20, 21 and 23 as they relate to SEQ ID NO: 16.

Group B-XVII, claim(s) 1-15, 17, 18, 20, 21 and 23 as they relate to SEQ ID NO: 17.

The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons. The special technical feature of the first claimed product is the sequence of SEQ ID NO: 1. None of the other sequences share this special technical feature, as each defines a separate contribution over the art.

IN ORDER TO BE FULLY RESPONSIVE, APPLICANT MUST CHOOSE ONE GROUP FROM A-I THROUGH A-VII **AND** ONE GROUP FROM B-I THROUGH B-XVII.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nirmal Basi, Ph.D. whose telephone number is (571) 272-0868.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, Ph.D. can be reached on (571) 272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ECK



ELIZABETH KEMMERER
PRIMARY EXAMINER